

R E M A R K S

Claims 1-22 are pending in this Application. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the discussion that follows.

Claims 1-22 have been rejected under 35 U.S.C. §103(a) as being anticipated by U.S. Pat. Publ. No. US 2003/0028518 to Mankoff. After a careful review of the claims (as amended), it has been concluded that the rejections are improper and the rejections are, therefore, traversed.

Claims Rejections - §103(a)

In particular, the Examiner asserts that

"Mankoff discloses a paperless coupon redemption system in which a coupon is associated with a customer's credit card [0015]. It is disclosed that the merchant sends data of the purchase to the card-matching agent, who would then match the credit card transaction to the appropriate consumer's coupon database in order to determine whether a discount should be applied. If the condition of the offer are met, a discount would be applied and a notice of the discount to the consumer could be delivered to the retail location itself at the time of purchase. There is disclosed a display in which the coupon offer may be displayed [0031]. Mankoff does not specifically disclose that the coupons are presented to the consumer at the register. However, such "at register" offers are old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include known "at register" coupon offers in the system of Mankoff, thereby enticing the consumer to purchase store selected items. If not inherent, it is also old and well known to provide the cost of an item and its discount on a receipt, i.e. display the cost and discount. It would have been obvious to a person of ordinary skill in the art at the time of the invention to display the cost and discount on an item in order to inform the user of the actual purchase price for accounting purposes. The credit card identifier is

inherently detected when the credit card is presented for use."

In response, independent claims 1, 11 and 20 have been further limited to a couponing system sponsored by a credit card company and to a credit card provided by the sponsoring credit card company. Support for the additional limitations may be found within the specification at paragraph [0013].

It is noted first in this regard that the claims are limited to the method step of (and apparatus for) "searching a database to identify a coupon that provides a discount on a purchase price of the item when used with a predetermined credit card provided by the sponsoring credit card company". Instead of using a predetermined credit card provided by the sponsoring credit card company, Mankoff uses any "consumer's payment systems (e.g., credit card, debit card, bank card, or other payment system)" (Mankoff, par. [0011]).

It is noted next that independent claims 1, 11 and 20 have also been further limited to the method step of (and apparatus for) "displaying at the point of sale the calculated discount available to the consumer based upon use of the predetermined credit card and which calculated discount is not applicable with competing credit cards". Support for this additional limitation may be found within the specification at paragraph [0026]. In contrast, Mankoff fails to provide any teaching or suggestion of displaying the discounts available through use of a predetermined credit card.

The Examiner asserts that "such 'at register' offers are old and well known in the art" (Office Action of 5/2/05, page 3). However, the claims are directed to a specific combination of elements that is not taught or suggested by the prior art. In this case, the claims are directed to "at register" offers that are based upon use of a predetermined credit card. Since Mankoff provides no teaching with regard to the use of a predetermined credit card, there would be no reason to combine any "at

register" offer with the use of a predetermined credit card.

The Examiner asserts that "If not inherent, it is also old and well known to provide the cost of an item and its discount on a receipt, i.e. display the cost and discount" (Office Action of 5/2/05, page 3). However, the Examiner offers no basis for such apparent conjecture.

If the Examiner is taking Official Notice that the display of cost and discount are well known in this context, then it is respectfully requested that the Examiner provide references establishing such knowledge, as required by MPEP §2144.03 and 37 CFR §1.104(d)(1). If the Examiner is relying upon his own personal knowledge, then an affidavit establishing the basis of such knowledge is respectfully requested as required by 37 CFR §1.104(d)(2).

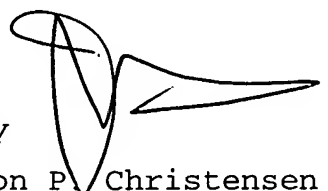
Further, the claimed invention solves a different problem than that of Mankoff. For example, Mankoff is directed to "fraud and fraud detection, auditing of paper coupons, and with training of personnel at the POS" (Mankoff, par. [0005]). In contrast, the claimed invention is directed to a couponing system 10 that "allows competing credit card companies to encourage use of the respective credit cards in a manner that may not incur any direct cost to the credit card company" (specification, par. [0029]). Since Mankoff and the claimed invention have different objectives, Mankoff provides no basis for a rejection under 35 U.S.C. §103(a).

For any of the above reasons, Mankoff fails to teach or suggest each and every claim limitation, as required by MPEP §2143.03. Since Mankoff fails to teach each and every claim limitation, the rejections are believed to be improper and should be withdrawn.

3. The allowance of claims 1-22 as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would

expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,
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